

AMENDMENT UNDER 37 C.F.R. § 1.111  
U.S. Appln. No. 09/608,436

layer facing each other,

wherein grooves for writing information, and lands adjacent to said grooves, are formed in and on said first recording layer and said second recording layer; and

wherein said grooves in said first recording layer and in said second recording layer have substantially the same thickness, while said grooves are thicker than said lands.

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### REMARKS

Claims 1-6 have been examined. Claims 2-6 have been rejected under 35 U.S.C. § 112, second paragraph, and claims 1-6 have been rejected under 35 U.S.C. § 103(a).

#### **I. Request for initialed Form PTO-1449**

Applicants respectfully request the Examiner to include an initialed copy of the Form PTO-1449 (submitted on January 7, 2002) with the next Office Action.

#### **II. Rejection under 35 U.S.C. § 112, second paragraph**

The Examiner has rejected claims 2-6 under 35 U.S.C. § 112, second paragraph, because the term “substantially” contained in claims 2-4 is a relative term and renders the claims indefinite.

Applicants respectfully disagree that the term “substantially” renders the claims indefinite. For example, the Court of Appeals for the Federal Circuit (“CAFC”) has often stated that terms such as “substantially equal” do not render a claim indefinite, as long as “one of

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ordinary skill in the art would understand what is claimed. . .in light of the specification” even if experimentation may be needed. Andrew Corp. v. Gabriel Electronics, Inc., 847 F.2d 819, 821 (Fed. Cir.), *cert denied*, 488 U.S. 927 (1988); see also, Cedarapids, Inc. v. Nordberg, Inc., 895 F.Supp. 1230, 1252 (N.D. Iowa 1995); U.S. Philips Corp., v. National Micronetics, Inc., 188 U.S.P.Q. 662, 667-8 (S.D.N.Y. 1976).

With respect to claim 2, Applicants submit that the phrase “substantially the same thickness” is not indefinite. For instance, an illustrative, non-limiting example of such use of term “substantially” is described on page 11 of the present application. Specifically, page 11, lines 13-15, states that the thickness dL1 for a land L of the layer 2 is substantially equal to the thickness dL2 for a land L of the layer 5. Moreover, page 11, lines 18-23, describe an example of the thickness dL1 as being approximately 0.1039  $\mu\text{m}$  and describe an example of the thickness dL2 as being approximately 0.1196  $\mu\text{m}$ .

In light of the discussion above, Applicants submit that the term “substantially” in claim 2 does not render the claim indefinite. Moreover, Applicants submit that such term does not render claims 3 and 4 indefinite for similar reasons.

### **III. Rejection under 35 U.S.C. § 103(a) over U.S.P. 5,881,032 to Ito et al. (“Ito”)**

Claims 1-6 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Ito.

#### **A. Claim 1**

Since claim 1 has been cancelled without prejudice or disclaimer, the rejection of such claim is moot.

**B. Claim 2**

Applicants submit that claim 2 is patentable over Ito. For example, claim 2 states that the grooves in the first recording layer have substantially the same thickness as the grooves in the second recording layer and that the grooves are thicker than the lands. On the other hand, Ito does not even remotely disclose or suggest the relative thicknesses of the grooves and the lands. On page 3 of the Office Action, the Examiner acknowledges that Ito does not disclose such thicknesses but states, without any evidence, that thickness is a matter of optimization and that discovering optimum or workable ranges involves routine skill in the art. Applicants submit that the Examiner's reliance on the "per se" rule that optimizing thickness would have been obvious is improper.

Specifically, as noted by the CAFC, "[t]his method of analysis is founded on legal error because it substitutes supposed per se rules for the particularized inquiry required by section 103. It necessarily produces erroneous results." In re Ochiai, 71 F.3d 1565, 1570, 37 U.S.P.Q.2d (BNA) 1127, 1132 (Fed. Cir. 1995). In fact, in In re Ochiai, the Court provided a detailed clarification of what it perceived to be a frequent misunderstanding among examiners.

The use of per se rules, while undoubtedly less laborious than a searching comparison of the claimed invention--including all its limitations--with the teachings of the prior art, flouts section 103 and the fundamental case law applying it. Per se rules that eliminate the need for fact-specific analysis of claims and prior art may be administratively convenient for PTO examiners and the Board. Indeed, they have been sanctioned by the Board as well. But reliance on per se rules of obviousness is legally incorrect and must cease. Any such administrative convenience is simply inconsistent with section 103, which, according to Graham and its progeny, entitles an applicant to issuance of an otherwise proper patent unless the PTO establishes that the invention as claimed in the application is obvious over cited prior art, based on the specific comparison

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of that prior art with claim limitations. We once again hold today that our precedents do not establish any per se rules of obviousness, just as those precedents themselves expressly declined to create such rules. Any conflicts as may be perceived to exist derive from an impermissible effort to extract per se rules from decisions that disavow precisely such extraction. (Emphasis added)

In re Ochiai, 71 F.3d 1565, 1572, 37 U.S.P.Q.2d (BNA) 1127, 1134 (Fed. Cir. 1995).

Accordingly, Applicants submit that claim 2 is patentable over Ito.

**C. Claims 3-6**

Since claims 3-6 depend upon claim 2, Applicants submit that they are patentable at least by virtue of their dependency.

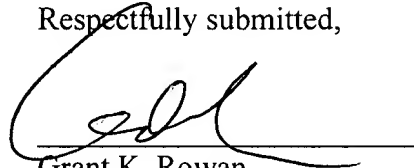
**IV. Conclusion**

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

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Applicants hereby petition for any extension of time which may be required to maintain the pendency of this case, and any required fee, except for the Issue Fee, for such extension is to be charged to Deposit Account No. 19-4880.

Respectfully submitted,



Grant K. Rowan  
Registration No. 41,278

SUGHRUE MION, PLLC  
2100 Pennsylvania Avenue, N.W.  
Washington, D.C. 20037-3213  
Telephone: (202) 293-7060  
Facsimile: (202) 293-7860

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**APPENDIX**

**VERSION WITH MARKINGS TO SHOW CHANGES MADE**

**IN THE CLAIMS:**

**The claims are amended as follows:**

2. (Once amended) An [The] information recording medium [according to claim 1],  
comprising:

a first information recording/reproduction unit formed by sequentially laminating on a  
first transparent substrate a first recording layer and a translucent layer, at the least;

a second information recording/reproduction unit formed by sequentially laminating on a  
second transparent substrate a reflection layer and a second recording layer, at the least; and

a transparent bonding layer for bonding said translucent layer and said second recording  
layer facing each other,

wherein grooves for writing information, and lands adjacent to said grooves, are formed  
in and on said first recording layer and said second recording layer; and

wherein said grooves in said first recording layer and in said second recording layer have  
substantially the same thickness, while said grooves are thicker than said lands.